

REMARKS / ARGUMENTS

The present application includes pending claims 1-36, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-2, 10-14, 22-26, and 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 5,740,526 ("Bonta") in view of US 7,324,783 ("Anderson"). Claims 3-9, 15-21, and 27-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonta and Anderson, further in view of US 5,465,410 ("Hiben").

The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure, Rev. 6, Sep. 2007 ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” (citing *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Bonta and Anderson Does Not Render Claims 1-2, 10-14, 22-26, and 34-36 Unpatentable

The Applicant now turns to the rejection of claims 1-2, 10-14, 22-26, and 34-36 as being unpatentable over Bonta in view of Anderson. The Applicant notes that the proposed combination of Bonta and Anderson forms the basis for all of the pending rejections.

A. Independent Claims 1, 13, and 25

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Bonta and Anderson does not disclose or suggest at least the limitation of “selecting at least one of said plurality of signal paths for receiving a signal, wherein said selecting is based on at least one of the modified signal quality metrics,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following:

Referring to Claim 1, Bonta teaches a method for choosing at least one signal path, the method comprising: Determining a signal quality metric for each of a plurality of signal paths (see col. 2, lines 53-57); and Selecting at least one of said plurality of signal paths for receiving a signal, wherein said selecting is based on the at least one of the signal quality metric (see col. 2, line 62 to col. 3, line 4).

Bonta does not teach modifying the determined signal quality metric for a signal path. Anderson teaches modifying the determined signal quality metric for a signal path (see col. 7, lines 29-46 noting that this process can be applied to all antenna elements of Bonta).

See the Final Office Action at page 2. The Examiner relies for support on col. 2, line 62 to col. 3, line 4 of Bonta, which discloses a method for selecting two of a plurality of antennas for receiving a signal. More specifically, Bonta measures a first signal quality metric and a second signal quality metric for a first and second antenna, respectively. If the two metrics differ by a threshold, then a third signal quality metric is measured for a third antenna. A primary and a secondary antenna are then selected based on the three measured signal quality metrics. In

this regard, Bonta discloses that the receive signal path (determined by the primary and secondary antennas) is selected only based on original and unmodified signal quality metrics, with the use of a threshold value. Bonta, therefore, does not disclose that any of the signal quality metrics are modified or that the selecting of a receive signal path is based on at least one modified signal quality metric.

Anderson does not overcome the above deficiency of Bonta. Anderson discloses a method for estimating a signal-to-noise-plus-interference ratio (SNIR), and then correcting the estimated SNIR to alleviate a bias term under conditions of low signal-to-noise ratio. See Anderson at col. 1, lines 31-34. In this regard, Anderson also does not disclose that selecting of a receive signal path is based on at least one modified signal quality metric.

Therefore, the Applicant maintains that the combination of Bonta and Anderson does not disclose or suggest at least the limitation of "selecting at least one of said plurality of signal paths for receiving a signal, wherein said selecting is based on at least one of the modified signal quality metrics," as recited by the Applicant in independent claim 1.

The Applicant also respectfully draw the attention of the Examiner to the prohibitions as set forth in M.P.E.P. § 2143.01, which states that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are

not sufficient to render the claims *prima facie* obvious.” See M.P.E.P. § 2143.01. Regardless of what Anderson allegedly teaches, Anderson cannot modify Bonta to use modified signal quality metric as this would present a radical change or an extreme departure from the principle operation of Bonta. As explained above, Bonta uses original and unmodified signal quality metrics from two antennas, where the difference of the two measured quality metrics is compared to a threshold for purposes of determining whether or not to use a third signal quality metric. If, *arguendo*, Bonta is to use modified signal quality metric, this would result in a deviation of the difference between the two metrics and incorrect application of the threshold value (note that the threshold value is set for use with regard to originally measured and unmodified signal quality metrics). This will also lead to incorrect determination of whether or not to use the third signal quality metric. For at least these reasons, the proposed modification of Bonta is prohibited and the obviousness rejection cannot be maintained.

Accordingly, the proposed combination of Bonta and Anderson does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 13 and 25 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 13 and 25 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2, 10-12, 14, 22-24, 26, and 34-36

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 13, and 25 under 35 U.S.C. § 103(a) has been overcome and request that the rejection be withdrawn. Additionally, claims 2, 10-12, 14, 22-24, 26, and 34-36 depend from independent claims 1, 13, and 25 and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2, 10-12, 14, 22-24, 26, and 34-36.

II. Rejection of Dependent Claims 3-9, 15-21, and 27-33

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 13, and 25 under 35 U.S.C. § 103(a) has been overcome and request that the rejection be withdrawn. Additionally, since the additional cited reference (Hiben) does not overcome the deficiencies of Bonta and Anderson, claims 3-9, 15-21, and 27-33 depend from independent claims 1, 13, and 25, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 3-9, 15-21, and 27-33.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-36 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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/Ognyan I. Beremski/

Ognyan Beremski, Esq.
Registration No. 51,458
Attorney for Applicant

MCANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET, 34TH FLOOR
CHICAGO, ILLINOIS 60661
(312) 775-8000

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